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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,584	06/08/2000	Tai A. Ly	4000/10	1223
35795	7590	08/16/2005	EXAMINER	
JONATHAN T. KAPLAN ATTORNEY AT LAW 10800 SE 17TH CIRCLE SUITE E66 VANCOUVER, WA 98664			THOMPSON, ANNETTE M	
			ART UNIT	PAPER NUMBER
			2825	

DATE MAILED: 08/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/590,584

Applicant(s)

LY ET AL.

Examiner

A. M. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-34 is/are allowed.
- 6) ☒ Claim(s) 35-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Reissue Application***

1. Applicants' Amendment to 09/590,584 has been reviewed and remarks considered. The specification and drawings are amended. Claims 4, 5, 25, 26, 29, 30, and 33, and 34 are amended. Claims 1-40 are pending.
2. Applicants' amendment is persuasive in part. However, Applicants' remarks indicates considerable confusion about what constitutes appropriate contents of a reissue application. Therefore, before launching into the currently applicable rejections and objections on the merits, a review of reissue contents with respect to the instant application may prove instructive.
3. 37 C.F.R. 1.173 provides in pertinent part:
  - (a) Contents of a reissue application. An application for reissue must contain the entire specification, including the claims, and the drawings of the patent. No new matter shall be introduced into the application.
4. The contents of Applicants' reissue application, the instant 09/590,584, includes specification, claims, drawings and two appendices, designated Appendix A and Appendix B of patent 5,764,951, the patent on which the reissue application 09/590,584 is based.
5. The patent Appendices A and B, although part of the original filing, were not part of the printed patent because they were contained on pages located after the claims. In the instant reissue application, Applicants have amended the specification and added most of the text of the Appendices before the claims, ostensibly to enable the printing of the Appendices upon issuance.

6. Appendices A and B are non-patent literature that the formal specification incorrectly identified as being *incorporated by reference*. Although reference to the Appendices is proper, **reference to them as being “incorporated by reference” is improper** because at the time of the original application filing, both pieces of non-patent literature in Appendix A and B were unpublished documents. Unpublished documents cannot be incorporated by reference, therefore, it remains mandatory that Applicants delete the phrase “incorporated by reference” when referencing Appendix A and Appendix B in the formal specification.

7. A mere format change by rearranging the position of the Appendices (i.e. placing them prior to the claim recitation section) would be of minor consequence. Here, however, Applicants have not only placed the Appendices before the claims but also edited and extracted sections of both Appendices and placed them in the formal specification. The extracted sections that Applicants have placed from the Appendices into the formal specification constitute **new matter** and must be deleted. Whatever drawings and text that were part of the original Appendices contents must remain in the Appendices.

8. Finally, Appendix, as defined by Merriam Webster’s Collegiate Dictionary, tenth edition, 1998, means *supplementary material usually attached at the end of a piece of writing*. Although Applicants may change the location of the Appendices, in this case, Applicants may not weave text or drawing sections from the Appendices into the subject matter of the formal specification, nor may Applicants edit the non-patent literature that is the subject matter of the Appendices to include sections of the formal specification.

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Applicants' Appendices must remain unedited with its location at the end of Applicants' specification either before or after the claims.

### ***Drawings***

9. The drawings are objected to because Figures 29a, 29b, 29c, 30a, 30b, 31, 32a, 32b, 32c, 33a, 33b, 34a, 34b, 34c, 34d, 35a, 35b, 36a, 36b, 36c, 36d, 37a, 37b, 38, 39a, 39b, 40, 41, 42, 43, 44a, 44b, 45 constitute new matter and therefore must be cancelled or deleted. Corrected drawing sheets excluding the drawings and in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

***Incorporation By Reference***

10. The attempt to incorporate subject matter into this application by reference to an Appendix B entitled Behavioral Synthesis Methodology for HDL-Based Specification and Validation by D. Knapp et al., (authors and inventorship are identical) and an Appendix A entitled Scheduling using Behavioral Templates by T. Ly et al. (authors and inventorship are identical) is improper for the following reasons: 1) Applicants attempt to ***incorporate by reference*** publications with publication dates that are later (June 12-16, 1995) than the filing date of the original application (May 12, 1995). Literature that was not published or in the public domain at the time of application filing cannot be incorporated by reference.

11. Further, even if the incorporation of the publications were somehow considered proper, Applicants would not be entitled to amend the specification to include the texts of the entire publication. Applicant is only entitled to that portion of the publication that contains the subject matter specifically referenced in the application. In the instant case, for the D. Knapp et al. publication, the subject matter would be scheduling modes; for the T. Ly et al. publication, the subject matter would be templates. Applicants would be required to insert information regarding the pertinent subject matter or provide the textual location of the subject matter in the references. Reference MPEP §608.01(p), I. Incorporation By Reference.

12. The amendment filed 24 March 2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment

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shall introduce new matter into the disclosure of the invention. Applicants' extraction of the Appendices sections and insertion of those same sections into the formal specification is improper and the inserted sections must be deleted from the formal specification. Further, Applicants have edited the contents of the Appendices (i.e. the text of the non-patent literature has been substantially edited). Applicants must restore the text of the original Appendices

13. Further and more specifically, with respect to deletions: in the Drawings, cancel all the new Figures: 29a, 29b, 29c, 30a, 30b, 31, 32a, 32b, 32c, 33a, 33b, 34a, 34b, 34c, 34d, 35a, 35b, 36a, 36b, 36c, 36d, 37a, 37b, 38, 39a, 39b, 40, 41, 42, 43, 44a, 44b, 45. In the specification 1) immediately before the last line of page 8, and before the first line of page 9, delete all the text (referencing the new drawings) in its entirety; 2) Immediately below the last line of page 28, and before the first line of page 29, replace the text of Appendices A and B with the originally filed text and drawings of Appendices A and B.

Applicant is required to cancel the new matter in the reply to this Office Action and make the requisite edits.

14. Further, in the specification, at page 14, line 14, delete "and is hereby incorporated by reference". In the specification at page 4, at line 7, delete "and is hereby incorporated by reference".

### ***Reissue Applications***

15. Claims 35-40 are rejected under 35 U.S.C. 251 as being based upon new matter added to the patent for which reissue is sought. The added material which is not

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supported by the prior patent is as follows: Applicants' formal specification as originally filed does not include support for the term "clock statement". Applicants' Appendices A and B may not be referenced in the specification as being "incorporated by reference".

***Claim Rejections - 35 USC § 112***

16. The following is a quotation of the **first** paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

17. Claims 35-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The term ***clock statement*** is not enabled by Applicants' specification.

***Remarks***

18. The USPTO conducts a de novo examination of reissue applications. 37 C.F.R. 1.176 (a) provides in pertinent part,

(a) A reissue application will be examined in the same manner as a non-reissue, non-provisional application, and will be subject to all the requirements of the rules related to non-reissue applications.

19. Therefore, although this issue of incorporation by reference may have been overlooked during the first examination proceedings leading to issuance of application 08/440,554 into U.S. Patent 5,764,951, this does not preclude the matter from review in the current examination. The incorporation by reference of the non-published literature



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was improper during the examination proceeding of the first application and that status currently remains unchanged.

20. Applicants are correct in asserting entitlement to reformat the non-patent literature that is the subject matter of appendices A and B and so incorporate its contents into the specification. Applicants state in Remarks,

Further, applicants respectfully direct the Examiner's attention to the fact that the USPTO routinely recognizes informal appendices as part of an application as-filed. Even a casual review of the USPTO Patent Application Full Text and Image Database, sorted by applications whose specification include the word "appendix" reveals many instances of this. As simply one example, applicants direct the Examiner's attention to the following United States Patent Application: 20050144240, filed June 30, 2005.

Indeed, Applicants' cited example of United States Patent Application publication 20050144240 ('240 publication) references an Appendix A in paragraph [0113] as follows:

The present invention is described in further detail in a technical report document appended hereto as Appendix A."

21. However, Applicants' cited example distinguishes itself from the instant application in that the Appendix of the '240 publication is referenced as being "incorporated by reference." Contrarily, In the instant application, Applicants persist in asserting the validity of "incorporating by reference" the non-patent literature that is the subject of stated Appendices A and B. Examiner does not agree with Applicants' assertion.

22. First of all, although entitled to reformat and include the non-patent literature, Applicants are not entitled to “incorporate by reference” this non-patent literature material or state this as the basis for inclusion of the Appendices within the specification. The MPEP provides policy on the incorporation by reference of non-essential subject matter. “Nonessential subject matter may be incorporated by reference to . . . (3) **non-patent publications**. (emphasis added). Most notably, the subject matter of Applicants’ Appendices A and B were *not* publications at the time of the filing of the original application 08/440,554, so incorporation by reference is inapplicable. Application 08/440,554 was filed on May 12, 1995. The publication dates of the non-patent literature of Appendix A, Scheduling using Behavioral Templates and Appendix B, Behavioral Synthesis Methodology for HDL-based Specification and Validation are June 12, 1995. Since a disclosure must be complete as of the time of the filing date, Applicants’ attempt to *incorporate by reference* this non-patent literature is improper. Accordingly, Applicants are required, *supra*, to amend the specification and delete the “incorporated by reference” phrases at page 4, line 7 and page 14, line 14. Moreover, in order to minimize the burden on the public in searching for the material referenced in the Appendices, Applicants are additionally required to amend the disclosure and identify (page and line numbers) the specific portions of the referenced appendices where the background information .

23. Finally, Applicants reference discussing “this issue with the USPTO Office of Patent and Legal Administration” and state that “it is in agreement with the applicants.” Examiner encourage Applicants to review 37 C.F.R. 1.2 which should remind Applicants

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that off the record and hearsay discussions do not carry any weight or merit during patent prosecution before the USPTO. Accordingly, the outcome of any discussions with the Office of Patent and Legal Administration does not affect the instant determination of the Examiner which is made in accordance with USPTO policy and rules.

### ***Conclusion***

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25. Any inquiry concerning this communication or earlier communications should be directed to Examiner A.M. Thompson whose telephone number is (571) 272-1909. The Examiner can usually be reached Monday thru Friday from 8:00 a.m. to 4:30 p.m..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

26. Responses to this action should be mailed to the appropriate mail stop:

Mail Stop \_\_\_\_\_

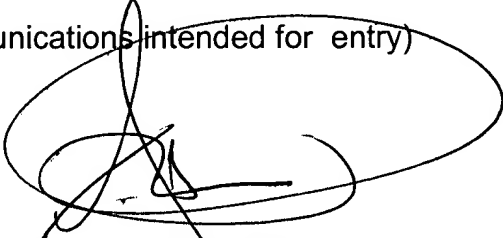
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